

I. REJECTION OF CLAIMS 43-49 AND 56

Claims 43-49 and 56 remain rejected under 35 USC §103(a) based on *Peeters* in view of *Arai et al.* This rejection is respectfully traversed for at least the following reasons.

a. Claims 43-46 and 56

The Examiner contends that *Peeters* teaches all of the features of claim 43 with the exception of the particular means for irradiating the resin material. The Examiner asserts that *Arai et al.* makes up for the deficiencies in *Peeters* by teaching a means for providing for the irradiation of the resin material. According to the Examiner, it would have been obvious to modify the teachings of *Peeters* to include the irradiation means of *Arai et al.* so as to result in the apparatus of claim 43.

It is significant to note, however, that there are several distinctions between the invention as recited in claim 43 and the combined teachings of *Peeters* and *Arai et al.* Thus, even if the teachings were combined as proposed by the Examiner the claimed invention would not result.

Peeters describes an apparatus and method for providing a substrate with an optically readable information disc. As is shown in Fig. 1, *Peeters* teaches the manufacture of an intermediate product including a substrate 3 and a disc hub 8. (Col. 6, Ins. 45-68). *Peeters* later discusses, in relation to Fig. 3, the construction of an information disc 17 which is made up of two such intermediate products having two substrates 3 each having a separate disc hub 8. (Col. 9, Ins. 3 + +).

Referring again to Fig. 1 of *Peeters* et al., the apparatus for making each intermediate product 3,8 includes a mold 1 having a base 1A. A structure carrier 1B is fixed to the base 1A. As is discussed beginning in Col. 6, line 4 of *Peeters*, the upper side of the structure carrier 1B includes a mold structure 2. The mold structure 2 is the negative of the structure to be formed on the substrate 3 to be produced.

In other words, the mold structure 2 will have a land/groove where a groove/land is to be formed on a structure on the substrate 3, for example. In this manner, the mold structure 2 can serve as a master mold for producing a plurality of information discs analogous to the pressing of a vinyl album.

Thus, it will be appreciated that the mold 1, base 1A, carrier 1B and mold structure 2 in Fig. 1 of *Peeters* make up part of an apparatus for making intermediate products 3,8 of an information disc 17. The mold 1, base 1A, carrier 1B and mold structure 2 do not make up any part of the information disc which is to be produced.

Peeters describes the manner in which the intermediate product 3,8 is produced beginning at Col. 6, line 4 thru Col. 8, line 9. In particular, a ring of liquid molding resin 4 is applied to the mold 1 near the center of the mold structure 2. A substrate 3 which has been preformed is then placed on the molding resin 4 and the resin is spread in a radial direction to form a thin layer 4 atop the mold structure 2.

The substrate 3 is transparent and the resin layer 4 thereunder is exposed to radiation in order to cure the resin. The thus formed reproduction layer 4 then adheres to the substrate 3 so that after curing the substrate 3 with the reproduction layer 4 can be taken from the mold 1 (including the mold structure 2) while maintaining the structure reproduced in the reproductions layer (i.e., the positive impression of the mold structure 2).

Included in the above described process in *Peeters* is the provision of a sheet metal disc hub 8. The hub 8 is secured to the center of the substrate 3 by an suitable means, such as an adhesive layer. Once the hub has been mounted to the substrate 3 it remains connected to the substrate 3 to form the intermediate product 3,8.

A feature of the invention described in *Peeters* is spherical or ball portion 12A on a stem 12B for guaranteeing excellent centering of the hub 8. (See, e.g., Col. 7, Ins. 1-60). The Examiner equates the ball 12A with the stopper recited in

claim 43. As will be better appreciated based on the following, however, the ball 12A by no means constitutes a stopper as claimed.

Claim 43 recites, *inter alia*, means for applying a radiation curable resin to a first substrate while the first substrate is being rotated. As best can be discerned from the basis for the rejection provided by the Examiner, the Examiner is equating the radiation curable resin of claim 43 with the ring of liquid molding resin used to form the reproduction layer 4 in *Peeters*. That being the case, the first substrate to which the molding resin is applied would have to be the mold structure 2 described in *Peeters*.

However, provided the mold structure 2 of *Peeters* corresponds to the first substrate recited in claim 43 as suggested by the Examiner, this begs the question of where is the stopper which is formed within the first substrate as recited in claim 43. Applicants respectfully submit that there is no reasonable manner whereby the ball 12A on which the Examiner relies upon as constituting the claimed stopper can be construed as being formed within the first substrate on which the radiation curable resin is applied according to claim 43.

Regardless of whether the Examiner is willing to give patentable weight to the intended purpose of the stopper, the mold structure 2 in *Peeters* does not have formed therein the purported "stopper" 12A as recited in claim 43. Thus, the rejection is improper and should be withdrawn.

Additionally, nowhere else in *Peeters* is it discussed where the ball 12A could constitute a stopper formed in a substrate on which the resin is applied.

Furthermore, the Examiner's reliance on Fig. 3 of *Peeters* for teaching rotating of the first and second substrates integrally is equally misplaced. Fig. 3 illustrates the combination of two intermediate products 3,8 in *Peeters*. Fig. 3 does not illustrate the rotation of the mold structure 2 (the purported first substrate) in any manner.

Accordingly, even if the teachings of the references were combined as proposed by the Examiner, the invention recited in claim 43 (and the claims dependent therefrom) would not result.

b. Claims 47-49

Claims 47-49 have been finally rejected under 35 USC §103(a) based on *Peeters* in view of *Arai et al.* as noted above. However, applicants note that the Examiner has not set forth even a *prima facie* basis for rejecting these claims as required for a 35 USC §103(a) type rejection. Moreover, the Examiner has failed to respond to applicants' substantive comments submitted in their previous response mailed on November 23, 1998. Absent some indication as to why such claims continue to be rejected and/or substantive response to applicants' comments regarding claims 47-49, it is difficult to move forward to further prosecution.

Accordingly, applicants hereby incorporate by reference the comments submitted in the response mailed on November 23, 1998 in relation to claims 47-49. More particularly, applicants note the patentable distinctions discussed in relation to claims 47, 48 and 49 on page 5 of the response.

Should the Examiner still not feel that the presently claimed invention represents allowable subject matter, applicants respectfully request that the Examiner issue a new, non-final Office Action which adequately sets forth the basis upon which claims 47-49 are rejected, and which addresses applicants' previously submitted arguments.

II. CONCLUSION

Accordingly, claims 43-49 and 56 are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account No. 18-0988.

Respectfully submitted,

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231.

Mark J. Paul

April 23, 1999
DATE